



PTO/SB/26 (09-04)

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**TERMINAL DISCLAIMER TO OBIATE A DOUBLE PATENTING  
REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)

YAI-002

In re Application of: Michael J. MAY *et al.*

Application No.: 09/847946-Conf. #6173

Filed: May 2, 2001

For: ANTI-INFLAMMATORY COMPOUNDS AND USES THEREOF

The owner\*, YALE UNIVERSITY, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. 6,864,355 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. \_\_\_\_\_

Dorothy K. Robinson  
Signature

9/15/05  
Date

Dorothy K. Robinson, V.P. & General Counsel

Typed or printed name

203 432-4949  
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

10/17/2005 HLE333 00000056 120080 09847946

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**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Michael J. MAY et al.

Application No./Patent No.: 09/847946

Filed/Issue Date: May 2, 2001

Entitled: ANTI-INFLAMMATORY COMPOUNDS AND USES THEREOF

YALE UNIVERSITY

, a

University

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or  
2. ☐ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Findeis, M.A.; Phillips, K.; and Hannig, G. To: Praecis Pharmaceuticals Inc.

The document was recorded in the United States Patent and Trademark Office at  
Reel 012891, Frame 0139, or for which a copy thereof is attached.

2. From: Praecis Pharmaceuticals Inc. To: Yale University

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: May, M.J. and Ghosh, S. To: Yale University

The document was recorded in the United States Patent and Trademark Office at  
Reel 012891, Frame 0051, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☒ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Dorothy K. Robinson  
Signature

9/15/05  
Date

Dorothy K. Robinson  
Printed or Typed Name

203 432-4949  
Telephone Number

Vice President & General Counsel  
Title



EXHIBIT A

PPI-119 patent family

AU 2001261164

AR P010102065

CA 2,414,296

CL 993/2001

EP 01935035.4

JP 2001-580978

NZ 522854

PCT/US01/14346

PH 1-2001-01061

TW 90110497

US 09/847,946

ZA 2002/9637

EXHIBIT B

ASSIGNMENT

WHEREAS, Praecis Pharmaceuticals, Inc., a corporation organized and existing under the laws of the State of Delaware, and with principal offices located in Waltham, Massachusetts, herein referred to as "ASSIGNOR," and Yale University entered into an Assignment with certain inventors to jointly acquire rights to PCT/USO1/14346 ("WO0183554A2: ANTI-INFLAMMATORY COMPOUNDS AND USES THEREOF").

WHEREAS, Yale University, a corporation of the State of Connecticut, located and doing business at Two Whitney Avenue, New Haven, CT 06511 in the United States, hereinafter referred to as "ASSIGNEE," is desirous of acquiring the entire interest to said patent application;

For good and valuable consideration, receipt of which is hereby acknowledged by ASSIGNOR, ASSIGNOR has assigned, and by these presents does assign to Assignee all right, title and interest in and to the invention and application claimed in said patent application; and to all U.S. and foreign counterparts (including patent, utility model and industrial designs), and in and to any Letters Patent and Registrations which may hereafter be granted on the same in the United States and all countries throughout the world, and to claim the priority from the application as provided by the Paris Convention. The right, title and interest is to be held and enjoyed by ASSIGNEE and ASSIGNEE's successors and assigns as fully and exclusively as it would have been held and enjoyed by ASSIGNOR had this Assignment not been made, for the full term of any Letters Patent and Registrations which may be granted thereon, or of any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof. ASSIGNOR further agree that they will, without charge to ASSIGNEE, but at ASSIGNEE's expense, (a) cooperate with ASSIGNEE in the prosecution of U.S. Patent applications and foreign counterparts on the invention and any improvements, (b) execute, verify, acknowledge and deliver all such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as ASSIGNEE lawfully may request to obtain or maintain Letters Patent and Registrations for the invention and improvements in any and all countries, and to vest title thereto in ASSIGNEE, or ASSIGNEE's successors and assigns.

IN WITNESS WHEREOF, I have hereunto set hand and seal this 26<sup>th</sup> day of June, 2003.

State of Massachusetts  
County of Middlesex

PRAECIS PHARMACEUTICALS, INC  
Kevin F. McLaughlin  
Kevin F. McLaughlin  
Chief Financial Officer

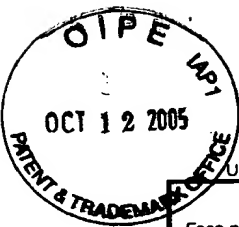
Subscribed and sworn to me on this 26<sup>th</sup> day of June, 2003.

[Signature]  
Notary Public (seal)  
My Commission Expires

HOURI ARTINIAN  
Notary Public

My Commission Expires May 28, 2004

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PTO/SB/17 (12-04v2)  
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<b>Effective on 12/08/2004.</b> <b>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</b>		<b>Complete if Known</b>	
<b>FEE TRANSMITTAL</b> <b>For FY 2005</b>		Application Number	09/847946-Conf. #6173
		Filing Date	May 2, 2001
		First Named Inventor	Michael J. MAY
		Examiner Name	A. U. Desai
		Art Unit	1653
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27	Attorney Docket No.	YAI-002	
<b>TOTAL AMOUNT OF PAYMENT</b>	<b>(\$)</b> 65.00		

<b>METHOD OF PAYMENT</b> (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: <b>12-0080</b> Deposit Account Name: <b>Lahive &amp; Cockfield, LLP</b>
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

<b>FEE CALCULATION</b>							
<b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>							
<b>Application Type</b>	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		<b>Fees Paid (\$)</b>
	<b>Fee (\$)</b>	<b>Small Entity Fee (\$)</b>	<b>Fee (\$)</b>	<b>Small Entity Fee (\$)</b>	<b>Fee (\$)</b>	<b>Small Entity Fee (\$)</b>	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
<b>2. EXCESS CLAIM FEES</b>							
<b>Fee Description</b>						<b>Fee (\$)</b>	<b>Small Entity Fee (\$)</b>
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
<b>Total Claims</b>		<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>		
11		- 31 =	x	=	<b>Fee (\$)</b>		<b>Fee Paid (\$)</b>
<b>Indep. Claims</b>		<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>			
4		- 7 =	x	=			
<b>3. APPLICATION SIZE FEE</b>							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>		<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>		
- 100 =	/50	(round up to a whole number) x		=			
<b>4. OTHER FEE(S)</b>							<b>Fees Paid (\$)</b>
Non-English Specification, \$130 fee (no small entity discount)							
Other (e.g., late filing surcharge): 2814 Statutory Disclaimer							65.00

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	56,266
Name (Print/Type)	Maria Laccotripe Zacharakis, Ph.D., J.D.	Telephone	(617) 227-7400
		Date	October 12, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EL 914047081 US, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Dated: October 12, 2005	Signature:  (Maria Laccotripe Zacharakis, Ph.D., J.D.)